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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,569	07/29/2003	Yannis Labrou	1634.1004	4126
21171	7590	05/03/2007		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/628,569

Applicant(s)

LABROU ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

***Status of Claims***

1. Claims 1-36 have been examined.

***Claim Objections***

2. Claims 9, 10, 12 and 13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 9 recites a consumer device capable of connecting a wireless network. Claim 12 recites "a mobile consumer device comprising *no display...*", while claim 6, from which claim 12 depends, recites "a display". Claims 10 and 13 are also objected to as they recite language similar to claims 9 and 12, respectively.

***Examiner's Remarks***

3. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior

art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)) (e.g. claim 3, "allows", claim 18 "operated by the merchant device", claim 35 "so that", claim 36 "to handle").

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the method step of "a processor executing...". Claim 1, however, from which claim 4 depends, is directed to an apparatus (i.e. "a computer system"). It has been held that a claim which purports to be both a product or machine and a process is ambiguous. Therefore, claim 4 is rejected under 35 USC 112, second paragraph as it fails to particularly point out and distinctly claim the invention (*Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)). Claims 5, 15, 17-25, 28, 29 and 33-35 are also rejected as each recites similar language.

Claims 5-35 are also rejected as each depends from claim 4.

Claim 6 recites "the mobile consumer device is packaged as a portable device". Further, claim 6 recites a lightweight processor, while Claim 4, from which claim 6 depends, also recites a processor. Therefore, it is unclear to one of ordinary skill whether the processor, interface, battery and display are part of the consumer device, or are in a package along with the consumer device (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989). Claim 7 is also rejected as it recites similar language.

Claims 7-16 are also rejected as each depends from claim 6.

Claims 9-11, 14 the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 9 is directed to structure. However, Applicant describes the claimed structure in terms of actions that may or may not be done (e.g. "capable of connecting"). It has been held that such a claim is indefinite and limitations that express how a structure may perform will not distinguish the claimed structure from the teachings of the prior art (*In re Collier*, 158 USPQ 266 (CCPA 1968); MPEP 2100-8, first column).

Claim 9 recites a consumer device capable of connecting a wireless network. However, claim 4, from which claim 9 depends recites a consumer device in connection with a wireless network. Similarly, claim 12 recites "a mobile consumer device comprising *no display...*", while claim 6, from which claim 12

depends, recites "a display". To one of ordinary skill the structure of the mobile device is unclear. Claims 10 and 13 are also rejected as each recites similar language.

Claim 5 recites the limitation "the Secure Transaction Protocol" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 27 recites the limitation "the mobile consumer device comprising cellular phone interface and proximity binding of the consumer" in lines 1-3. There is insufficient antecedent basis for this limitation in the claim.

Claims 28-35 are also rejected as each depends from claim 27.

Claim 29 recites the limitation "the merchant retail application program and the universal pervasive transaction framework application program" in lines 1-3. There is insufficient antecedent basis for this limitation in the claim.

Claims 30-32 are also rejected as each depends from claim 29.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al., U.S. Patent No. 5,256,863 in view of Nordenstam et al., WO 00/46959.

As per claims 1-36, Ferguson et al. teach a computer system comprising:

- a merchant operated device (abstract; figures 1 (items 6 and 8), 3 and 4; column/line 8/3-9/34)
- a transaction server device (abstract; figures 1 (item 10) and 8; column/line 14/62-17/5; column 18; lines 57-64; column 20, lines 9-58)
- one or more payment service devices (abstract; figure 1, item 22; column/line 15/60-16/2; column 18, lines 57-64; column 20, lines 20-28)
- a wired or wireless communication network between the merchant device and the server, and the server and the payment service devices (figure 1)

Ferguson et al. teach a user with a payment card making a purchase at the merchant operated device (abstract; figures 1 and 4; column/line 4/55-5/25; column 9, lines 5-11; column/line 15/60-16/2; column 18, lines 57-64; column 20, lines 20-28). However, Ferguson et al. do not specifically recite wireless networks for interfacing a user's card with the merchant device.

Nordenstam et al. teach a computer system comprising:

- a Bluetooth or any other wireless network (figures 1-3; page/line 11/18-15/10)
- a mobile device (e.g. PDA, phone) comprising a wireless interface, user input feature, web browser, a processor and biometric sensor (figures 1 and 3 (items 10A and B); page 9, lines 12-20; page 10, lines 5-29; page 11, lines 18-27; page 16, lines 24-30; page/line 25/30-26/12; page/line 26/22-27/5)
- a merchant device comprising a wireless interface (figure 3)

More specifically, Nordenstam et al. teach a user with a mobile device comprising a payment card (page 8, lines 10-30; page/line 9/12-11/17; page 24, lines 10-29) wherein the device/card is used to make purchases by wirelessly communicating payment card data to the merchant device (page 15, lines 26-32; page 16, lines 14-22; page 21, lines 5-25). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Ferguson et al. and Nordenstam et al. in order to reduce the amount of cards handled by a user and increase security ('959, page 2, lines 5-12).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Gershman et al. teach delivering internet personal and commerce services to a wireless device
- Pentel teaches a cellphone or other wireless device for communicating an order to a POS device, buyer can be at a remote location, credit or like card for purchases, security via card or physical characteristics of the buyer

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

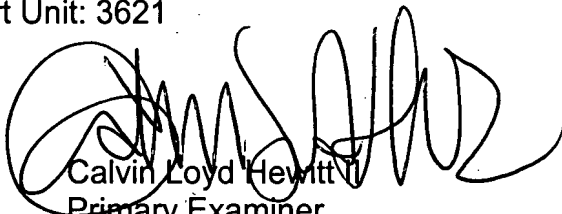
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Calvin Loyd Hewitt  
Primary Examiner

April 27, 2007